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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/802,787	03/18/2004	Shunpei Yamazaki	12732-0084002	5071

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EXAMINER
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NGUYEN, THINH T

ART UNIT	PAPER NUMBER
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2818

NOTIFICATION DATE	DELIVERY MODE
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11/12/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/802,787	<b>Applicant(s)</b> YAMAZAKI ET AL.	
	<b>Examiner</b> THINH T. NGUYEN	<b>Art Unit</b> 2818	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 July 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 71-110 is/are pending in the application.
- 4a) Of the above claim(s) 81-110 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 71-80 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. 10/012,370.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

1. Claims 71-110 are pending in the Application with claims 81-110 withdrawn from consideration as directed to non-elected invention.

#### *Double Patenting*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 71-80 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-48 of US patent 7,030,551 in view of Umeya ( US patent 6,028,581) thereafter Umeya 581

With regard to claim 71-80, Claims 1-48 discloses all the invention of claims 71-80 of the present invention including a portable electronic book (claim 6, 12, 24,30,36,48 of US patent 7,030,551) with plurality pf pixels with EL element and photoelectric conversion unit organized in a matrix ( usually in rectangular or square shape ) except for the specific use of an input pen

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and the specific that the photodetector in the pixel matrix can provide the mean for detecting the coordinate of the portions of the pixel

Umeya 581, however, discloses a potable electronic book ( column 1 lines 5-67, column 2 lines 52) that use an input pen ( the abstract ) and the photodetector in the pixel matrix can provide the mean for detecting the coordinate of the portions of the pixel ( fig 4, fig 7, column 2 lines 55-67 ) .

Note that due to use individual photodiode as a mean to detect light activity of an individual pixel of the Umeya 581 disclosure; the coordinate detection of individual pixel is either inherent or obvious because the pixels in Umeya 581 disclosure is organized in row and column ( fig 4, fig 5)

It would have been obvious to one of ordinary skill in the art the time the invention was made to incorporate this feature as taught by Umeya 581 into claims 1-48 of US patent 7,030,551 and come up with the inventions of claims 71-80 of the present application.

The rationale is as the following:

A person skilled in the art would have been motivated to use the input pen on the inventions of claims 1-48 of US Patent 7,030,551 for market penetration into the electronics book business in order to achieve commercial success and profitability.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The Examiner notes that the claims of this Application have the limitation in the preamble. Please note that preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

6. Claims 71,76-80 rejected under 35 U.S.C. 103(a) as being unpatentable over Yamauchi et al ( U.S. patent 5,640, 067) thereafter Yamauchi 067 in view of Bird ( U.S. patent 5,386,543) thereafter Bird 067.

With regard to claim 71, Yamauchi 067 discloses all the invention ( fig 4, column 1 lines 5-10 ) of a display that can incorporate into a portable electronic book comprising: a plurality of pixels arranged in a matrix shape, each of the plurality of pixels comprising an EL element ( fig 4 ). Not specific in Yamauchi 067 are the limitation wherein the device comprises a photoelectric conversion element over a same substrate; a means for making the EL element emit light; an input pen for reflecting a light emitted by the EL element and for inputting the light to the photoelectric conversion element of a portion of pixels among the plurality of pixels; and a means for detecting coordinates of the portion of the pixels. Bird 543 ( , fig 1, fib 5, the abstract) , however, discloses a display that can incorporate into an electronic book wherein the device

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comprises a photoelectric conversion element over a same substrate; a means for making the EL element emit light; an input pen for reflecting a light emitted by the EL element and for inputting the light to the photoelectric conversion element of a portion of pixels among the plurality of pixels; and a means for detecting coordinates of the portion of the pixels

It would have been obvious to one of ordinary skill in the art the time the invention was made to incorporate this feature as taught by Bird 543 into the device disclosed by Yamauchi 067 and come up with the inventions of claim 71 of the present application.

The rationale is as the following:

A person skilled in the art at the time the invention was made would have been motivated to make the Yamauchi 067 device to be interactive ( such as the use the input pen ) to improve this device for market expansion in order to achieve commercial success and profitability.

With regard to claims 76, Bird 543 ( fig 5,) discloses the use of photodiode for pixel light detection..

With regard to claim 77-79 , the features disclosed by those claims are the inherent or obvious features of an organic photo-diode known in the art at the time the invention was made

With regard to claim 80 , this claim is obvious over Yamauchi 067 in view of Bird 543 because the equivalent of a palm print or a finger print to a input pen disclosed by Bird 543 ( fig 1)

**ALLOWABLE SUBJECT MATTER**

9. Claims 72-75 would be allowable if Applicant can overcome the double patenting rejection of those claims and rewritten those claims in independent form that includes all the limitations of the base claim and any intervening claim.

Claim 72-75 are considered allowable since the prior fails to teach the additional limitations as recited in claims 72-75

10 When responding to the office action, Applicants are advised to provide the examiner with the line numbers and the page numbers in the application and/or references cited to assist the examiner to locate the appropriate paragraphs.

11 A shortened statutory period for response to this action is set to expire 3 (three) months and 0 (zero) day from the day of this letter. Failure to respond within the period for response will cause the application to be abandoned (see M.P.E.P. 710.02(b)).

12 Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d) in Application 10/012,370 which paper has been placed of record in the file.

### **CONCLUSION**

13 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thinh T Nguyen whose telephone number is 571-272-1790. The examiner can normally be reached on Monday-Friday 9:30am-6: 30pm.If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Loke can be reached at 571-272-1657.The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval [PAIR] system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**/Thinh T. Nguyen/**

**Patent Examiner**  
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